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09/955,594	09/05/2001	Phillip M. Ginsberg	CF/047	1177

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EXAMINER	
GREENE, DANIEL LAWSON	

ART UNIT	PAPER NUMBER
3694	

MAIL DATE	DELIVERY MODE
08/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/955,594	GINSBERG, PHILLIP M.	
	Examiner	Art Unit	
	Daniel L. Greene Jr.	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 May 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,4 and 6-33* is/are pending in the application.

4a) Of the above claim(s) *8,11,12,21 and 30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2, 4, 6, 7, 9, 10, 13-20, 22-29, 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 4/17/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 2, 4 and 6-33 are pending, Claims 8, 11, 12, 21 and 30 are withdrawn herein,accordingly an action on the merits of Claims 2, 4, 6, 7, 9, 10, 13-20, 22-29 and 31-33 follows.

Election/Restrictions

2. Applicant's election with traverse of species 1b, 2c wherein the trading price being monitored is electricity in the reply filed on 5/18/2007 is acknowledged. The traversal is on the ground(s) that the requirement for restriction is improper for multiple reasons. This is not found persuasive because:

a. The Examiner has applied the rules for restriction properly and correctly and has NOT deviated from the MPEP per applicant's allegations as expounded upon below. (See page 7, section I.1)

b. The originally acted upon invention is that set forth in the original claims 1-15 that the Examiner reviewed in order to establish the need for restriction mailed 1/17/2007. However upon further consideration the Examiner understands that the newly present claims are still drawn to the originally presented invention merely reworded. Accordingly the statement in section 3 of the previous Office action is withdrawn. (See page 7, section I.2)

c. The Examiner acknowledges the plethora of reasons for traversing a species restriction requirement as set forth in sections 806.04 of the MPEP,

however NONE of the reasons proffered by Applicant are persuasive as previously and currently explained. (See page 8, section I.3)

d. The Examiner has repeatedly stated that there is indeed a serious burden, See for examples, sections 4 and 6, of the previous Office action. Each species would require a different search, different search queries and different considerations that do present a serious burden. See MPEP 808.02 (R-5) (See page 8, section I.4)

e. A single species election must be closed ended otherwise other patentable species may still be present for examination. The Examiner has in no way contradicted the MPEP. The generic claims themselves set forth what is considered a reasonable number of species that the Examiner is already examining because they are "generic" to that multitude of species. The specific species set forth in the disclosure require the restriction. The Examiner has already cited the laws in support of said restriction. See, section 7a-c on pages 4-5 of the previous Office action mailed 4/18/07. Again per 35 USC 101 applicant may only receive ONE patent for ONE invention, not one patent containing a plurality of inventions such as those set forth in the claims. (See pages 8-9, sections I.5-7)

f. The restriction set forth in the 1/17/2007 Office action is proper in it dependencies of restriction since the base claims are generic. Accordingly the claims are to be examined in light of the species they are directed towards. Again, the Examiner is merely enforcing 35 USC 101 by examining only ONE

invention. Further, said requirement did indeed state the claims where the species are identified. (See page 9, section I.8)

g. Per 37 CFR 1.53 and MPEP 506(R-5), No new matter may be introduced into an application after it's filing date. Applicant's remarks attempting to elect a species that was not set forth in the disclosure as filed is indeed considered an attempt to introduce new matter into the application.

The Examiner has attempted to answer Applicant's contentions completely. In this regard the election restriction has been reviewed for proper construction so as to limit the claimed invention to ONE invention and as such is consistent with current USPTO practices.

Since applicant is of the opinion that the species set forth are not obvious variants then the Examiner can only surmise that the claims in each group are novel and nonobvious over each other because, for example, they have different modes of operation, effects, and limitations. However the Examiner can make no such conclusion without first performing a thorough examination of the invention and current state of the art in the applicable field of knowledge.

The requirement is still deemed proper and is therefore made **FINAL.**

3. Claims 8, 11, 12, 21 and 30 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/18/07.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 25-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in the preamble of claim 25, the invention is directed towards a method that is performed by a trader in a market. People are non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 4, 6, 7, 9-, 10, 13-20, 22-29 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2,352,844,A to Beuttell.

Regarding claims 2, 18 and 25, Beuttell sets forth a method and a computer program comprising the steps of:

by computer, identifying a trade of a traded instrument or item occurring at an outlier price deviating from a benchmark price, the benchmark price being a

price or range of prices at which the instrument or item would have traded in absence of market distortion, the identifying being based at least in part on monitoring prices at which trades of the instrument or item occur over a time interval; and

distributing at least a portion of profits earned because of the deviation of the price of the outlier-price trade from the benchmark price, to at least one of a plurality of distributee participants in a market for the traded instrument or item in, for example, The abstract, Fig.25, Page 2 lines 4-18, Page 3 lines 5-13, Page 4 lines 5-18, Page 9 lines 16 and 17, Page 10 line 31 to page 11 line 30, Page 45 lines 19-35, etc.

Regarding claims 4, 19, 26 and 27 and the limitation distributing the profits attributable to the deviation to at least one of the distributee market participants in proportion to a share of profits attributable to the deviation obtained from the distributee market, see for example, page 3 line 24 through page 5 line 3.

Regarding claim 6 and the limitation the monitoring of prices comprising sampling the trading price at pre-determined intervals, see for example, page 4 line 20 through page 5 line 13.

Regarding claims 7 and 28 and the limitation wherein the benchmark price is determined based at least in part by determining a running average trading price see for example, page 41, line 24 to page 42 line 20.

Regarding claim 9 and the limitation wherein the benchmark price is determined based at least in part by determining a mode trading price, see for example, page 33 line 33 to page 35 line 37.

Regarding claim 10 and the limitation wherein the benchmark price relative to which deviation of the outlier-priced trade is evaluated includes a range of benchmark trading prices, see for example, page 2 lines 4-6.

Regarding claim 11 and the limitation wherein the benchmark price relative to which deviation of the outlier-priced trade is evaluated includes a last-in-time trading price, see for example, page 3 lines 24-38.

Regarding claim 13 and the limitation implementing the method in an electronic trading platform see for example, the abstract.

Regarding claims 14 and 22 and the limitation wherein the instrument or item includes one or more of electricity, natural gas, energy, and oil see for example, page 1 lines 4-11.

Regarding claims 15 and 31 and the limitation the monitoring further comprising monitoring a plurality of trading prices, see for example, page 2 lines 4-6.

Regarding claims 16 and 23 and the limitation wherein the monitoring prices at which trades of the instrument or item occur over a time interval includes monitoring for prices remaining stable within a relatively small percentage range, it must be understood that Beuttell inherently includes this limitation because it is monitoring the prices regardless of what the market is doing or how little it is varying.

Regarding claims 17, 24 and 32 and the limitation wherein the prices monitored to determine a benchmark price include prices for trades occurring after the outlier-price trade, again Beuttell inherently includes this limitation because it is monitoring the prices continuously which would include trades performed after the outlier-price.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2, 4, 6, 7, 9, 10, 13-20, 22-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Clayton Antitrust Act of 1914 (hereafter CAA) in view of Both Energy and Electric Utilities State laws and regulations: price gouging AND Caffrey, "States try to deter power price gouging" 4/30/2001.

Applicant's invention is directed to an automated process of monitoring and dealing with price gouging. During the 1973 oil embargo, price gouging was discussed at length and laws were enacted to prevent/limit/punish such practices. See for example, NPL "V" State Laws and Regulations: Price Gouging. Applicant's invention is directed towards the method of ensuring these laws are enforced.

Regarding claims 2, 18 and 25, CAA sets forth a method comprising the steps of: identifying a trade of a traded instrument or item occurring at an outlier price deviating from a benchmark price, the benchmark price being a price or range of prices at which the instrument or item would have traded in absence of market distortion, the identifying being based at least in part on monitoring prices at which trades of the instrument or item occur over a time interval; and distributing at least a portion of profits earned because of the deviation of the price of the outlier-price trade from the benchmark price, to at least one of a plurality of distributee participants in a market for the traded instrument or item wherein it is understood that applicants invention is nothing more than the method of ensuring the CAA is enforced.

CAA does not explicitly disclose that a computer performs the method.

Resort may be had to the teaching of the case law, *In re Venner*, 120 USPQ 192 (CCPA 1958) and *In re Rundell*, 9 USPQ 220

"It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result"

Accordingly it is prima facia obvious to one of ordinary skill in the art to automate the monitoring of commodities to ensure that the laws are being followed. Further, the laws are applicable regardless of how they are implemented.

Regarding claims 4, 19, 26 and 27 and the limitation distributing the profits attributable to the deviation to at least one of the distributee market participants in proportion to a share of profits attributable to the deviation obtained from the distributee market, see for example, page 3, section 13b

Regarding claim 6 and the limitation the monitoring of prices comprising sampling the trading price at pre-determined intervals, this limitation is considered inherent in that it must be performed in order to establish what the normal consumer cost is in order to determine artificial price inflation or price gouging is taking place.

Claims 7 and 28 and the limitation wherein the benchmark price is determined based at least in part by determining a running average trading price is considered to be a statistically obvious manner of determining a benchmark, See for example, Caffrey page 3, 4th paragraph.

Claim 9 and the limitation wherein the benchmark price is determined based at least in part by determining a mode-trading price is considered to be a statistically obvious manner of determining a benchmark, see for example, Caffrey page 3, 4th paragraph.

Claim 10 and the limitation wherein the benchmark price relative to which deviation of the outlier-priced trade is evaluated includes a range of benchmark trading prices is considered inherent in that the benchmark will change as the market fluctuates. That is, the benchmark cannot statistically remain the same and will wander around the market accepted value.

Regarding claims 14 and 22 and the limitation wherein the instrument or item includes one or more of electricity, natural gas, energy, and oil, the laws apply to any commodity.

Regarding claims 15 and 31 and the limitation the monitoring further comprising monitoring a plurality of trading prices, again this limitation is inherent to the laws because NO commodity or price is exempt from the laws.

Regarding claims 16 and 23 and the limitation wherein the monitoring prices at which trades of the instrument or item occur over a time interval includes monitoring for prices remaining stable within a relatively small percentage range, again this is considered inherent to the monitoring process.

Regarding claims 17, 24 and 32 and the limitation wherein the prices monitored to determine a benchmark price include prices for trades occurring after the outlier-price trade one must understand that the laws are applicable at all times both during and after the laws are broken. Accordingly this is also an inherent limitation to the laws.

Conclusion

10. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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